

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Substance of Interview

At the outset, Applicants wish to thank Examiner Metzmaier for the courtesy of the interview accorded Applicants' representative.

Prior to the interview, the undersigned provided Examiner Metzmaier with a proposed amendment and remarks, a copy of which it is believed Examiner Metzmaier has made a part of the official filewrapper.

In the proposed response, Applicants proposed to amend the beginning of main claim 21 to read "A composition of matter consisting essentially of metal oxide colloids . . .". The other claims were proposed to be amended as necessary to be consistent with the proposed amendments to claim 21.

Claim 21 was also proposed to be amended at the very end to recite "wherein said metal oxide colloids are redispersible in a solution consisting of water."

An initial question posed to the Examiner was whether he'd be inclined to enter such an amendment "after-final." The Examiner indicated that he would not enter such an amendment "after-final."

Applicants expressed a willingness to file an RCE, whereupon the Examiner was questioned whether he would issue a first Office Action final rejection. The Examiner

indicated that he would not issue a first Office Action final rejection in the case where the proposed amendment was filed along with an RCE.

Applicants then explained how they believed the proposed amendments overcame all of the issues in the final rejection.

With respect to the objection to claims 40, 42 and 43, Applicants explained that these claims were proposed to be made independent.

With respect to the anticipation and obviousness rejections based on Moumen et al. (“Moumen”), *Chemical Materials*, 8: 1128-1134 (1996), Applicants explained that Moumen’s colloids were not “redispersible in a solution consisting of water,” as would be required by the instant claims.

With respect to the anticipation, obviousness and obviousness-type double patenting rejections based on Bonnemann et al. (“Bonnemann”), WO 96/17685, Applicants explained that Bonnemann’s colloids were metal colloids, not metal oxide colloids, and, therefore, Bonnemann’s colloids did not “consist essentially of metal oxide colloids,” as would be required by the instant claims.

In response, although the Examiner was initially inclined to believe that amendment along the proposed lines would remove Bonnemann as a reference, he expressed concern with the use of the “consisting essentially of” language. According to the Examiner, the burden was on Applicants to show what compositions would be excluded by such language. The Examiner suggested that Applicants use “comprising” language, and find some other way of distinguishing Bonnemann.

With respect to Moumen, the Examiner expressed the need to review and reconsider whether Applicants' evidence proved Moumen's colloids did not satisfy the "redispersibility" requirement proposed by Applicants.

Formal Response to Outstanding Issues in the Final Rejection

As suggested by the Examiner during the interview, Applicants have not adopted the "consisting essentially of" language previously proposed. Instead, Applicants have required in main claim 21 and elsewhere that the composition of matter claimed "comprise predominately metal oxide colloids" having the recited features. *Webster's New Collegiate Dictionary*, 1973, defines "predominate," in the only applicable definition for the term, as "to hold advantage in numbers or quantity." Thus, a person having ordinary skill in the art would understand that a composition that "comprises predominately metal oxide colloids" is mainly composed of such metal oxide colloids, and such colloids are not a small, insignificant portion of the composition.

Applicants respectfully submit that the new wording does not introduce new matter and is amply supported by the instant specification. Although the word "predominately" may not appear *ipsis verbis* in the application as filed, such literal support is not necessary in order to satisfy the written description requirement. In this regard, Applicants point out that in determining whether an amendment to a claim constitutes new matter, the question is not whether the added *word* is a word that is used in the application as filed, but whether the *concept* embodied by the added word is present in the original specification as filed. *See, e.g., In re Anderson*, 176 USPQ 331,

336 (CCPA 1973). Applicants respectfully submit that the instant specification discloses a number of inventive examples, wherein in each a person of ordinary skill in the art would recognize and appreciate that the metal oxide colloids produced were the predominate product. Consequently, the original specification supports Applicants' position that they possessed compositions comprising predominately metal oxide colloids exactly as now claimed. Therefore, the amendments along this line do not introduce new matter.

New claims 46-50 are supported by numbered paragraph 5) on page 5 of the instant specification.

New claims 51 and 52 are supported by numbered paragraphs 4) and 6) on page 5 of the specification and the examples.

Applicants do not believe that any of the amendments introduce new matter. An early notice to that effect is earnestly solicited.

Claims 40, 42 and 43 were objected to under 35 USC § 1.75(c) as being of improper dependent form for failing to limit the subject matter of a previous claim. In response, claims 40 and 42 have been made independent. As claim 43 depends on claim 42, this objection is clearly overcome.

Claims 40, 42 and 43 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants submit that the above-discussed amendments to claims 40 and 42 moot this rejection.

Claims 21, 23, 24, 26, 27, 29, 30, 32-35 and 37 were rejected under 35 USC § 102(b) as being anticipated by Moumen et al. (“Moumen”), *Chemical Materials*, 8: 1128-1134 (1996). In response, Applicants point out that they previously argued that Moumen’s colloids were redispersible in a mixture of *ethylene glycol and water*, and, therefore, were different than the instant colloids, which are redispersible in *water alone*. The Examiner countered that there was no evidence that there was no evidence that Moumen’s colloids would not be redispersible in water alone. However, Applicants respectfully submit that this can be reasonably inferred. Moumen would not have employed a mixture of ethylene glycol and water to stabilize his colloids if he truly believed they could be redispersed in water alone.

Further on this point, Applicants would call the Examiner’s attention to the accompanying article by Moumen, appearing in *J. Phys. Chem.*, 100: 1867-1873 (1996). This article discusses Fe/Co mixed oxide nanoparticles in the form of colloids like those discussed in the Moumen reference on which the Examiner relies. In the last paragraph of the Experimental Section II, in the right-hand column on page 1867, the author’s state: **“To prevent agglomeration**, magnetic particles [i.e., the Fe/Co colloids] are dispersed in 50% of *ethylene glycol in water*.” Incidentally, this is the same mix of ethylene glycol and water used in the Moumen reference relied on by the Examiner. Clearly, Moumen’s colloids would not be stable in water alone. Thus, Moumen has had to introduce ethylene glycol to provide stabilization, and to prevent agglomeration.

In view of the foregoing, Applicants respectfully submit that there is a clear difference between Moumen’s materials and what is required by the present claims.

Moumen's colloids are not redispersible in a solution consisting of water, as required by the instant claims. Consequently, Moumen cannot anticipate the instant claims.

Claims 21-24, 26-30, 32-35, 37-39 and 41 were rejected under 35 USC § 102(b) as being anticipated by Bonnemann et al. ("Bonnemann"), WO 96/17685. According to the Examiner, the concentration of metal oxide in the colloid is not defined. In response, Applicants have amended the claims to require that the composition "comprises predominately metal oxide colloids." Certainly, this is different from Bonnemann, whose composition consists of metal colloids, *not* metal oxide colloids.

With respect to the issue of reduction, Applicants again respectfully submit that a person having ordinary skill in the art would understand reading Bonnemann that it is the metal salt that is reduced, not any hypothetical metal oxide. It would be a curious thing for Bonnemann to make an explicit reference to reduction, yet with the intention that this be for an inherently disclosed oxide.

In view of the foregoing, Applicants respectfully submit that there is a clear difference between Bonnemann's materials and what is required by the present claims. Bonnemann's materials do not comprise predominately metal oxide colloids.

Claim 36 was rejected under 35 USC § 103(a) as being obvious over Moumen. In response, Applicants point out that this rejection was premised on Moumen anticipating the basic features of the present invention, which, as discussed above, is not, in fact, the case. Consequently, Applicants believe that the Examiner would be fully justified to reconsider and withdraw this rejection as well.

Claim 44 was rejected under 35 USC § 103(a) as being obvious over Bonnemann in view of Day et al. (“Day”), US 4,197,187. In response, Applicants point out that this rejection was premised on Bonnemann anticipating the basic features of the present invention, which, as discussed above, is not, in fact, the case. Consequently, Applicants believe that the Examiner would be fully justified to reconsider and withdraw this rejection as well.

Claims 21-24, 26-30, 32-35, 37-39 and 41 were rejected on the ground of obviousness-type double patenting as being unpatentable over claims 1-25 of US 6,090,746. In response, Applicants point out that this rejection was premised upon Bonnemann inherently producing metal oxide colloids, which, as discussed above, is not, in fact, the case. Consequently, Applicants believe that the Examiner would be fully justified to reconsider and withdraw this rejection as well.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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